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Bruce M. Dickens

(Name)

Bruce M. Dickens

(Signature)

Reissue Application No.:)	Group Art Unit: 2161
09/512,592)	
United States Patent No.:)	Examiner: Coby, F.
5,806,063)	
Issued: September 8, 1998)	Confirmation No. 3314
Applicant:)	
<u>Dickens-Soeder2000,LLC</u>)	
Reexamination Proceeding:)	
90/005,592)	
<u>Filed: December 21, 1999</u>)	
Reexamination Proceeding:)	
90/005,628)	
<u>Filed: February 2, 2000</u>)	
Reexamination Proceeding:)	
90/005,727)	
<u>Filed: May 16, 2000</u>)	
Reexamination Proceeding)	
90/006,541)	
<u>Filed February 2, 2003</u>)	

Applicant's Reply Brief

In response to the Examiner's Answer mailed on March 3, 2006, applicant responds as follows.

The Examiner has taken the position that Exhibit A adds new matter because Exhibit A was not published with the Dickens Patent as issued. The Examiner states that:

Applicant's argument regarding Exhibit A being filed originally with the application for the Dickens Patent is unfounded because the Dickens

patent ... does not include the codes presented by the applicant in
Appendix A [sic]. (Examiner's Answer, p. 4)

Applicant concurs that Exhibit A was not so published with the Dickens patent. That does not, however, change the fact that Exhibit A was filed with the original Specification of the Dickens patent as originally filed in the original prosecution of the dickens patent, U.S. Patent No. 5806063. The Examiner, by simply arguing that Exhibit a was not published with the Dickens patent as originally issued, must be considered to concede that the evidence submitted by applicant shows that Exhibit A was in fact filed with and was, therefore, a part of the Specification of the Dickens patent as originally filed. *Therefore, Exhibit A should have been published with the Dickens patent as issued.*

Applicant has, respectfully, been seeking to correct that mistake in the publication of the Dickens patent, first by Certificate of Correction, which the Examiner indicated was not appropriate¹ during the prosecution of a Reissue Application, and then by amendment to the Specification, which was rejected as adding new matter.

It is *not new matter if it was filed with the Specification of the Dickens patent as originally filed.*

The Examiner has asserted that because Exhibit A adds new matter, which it does not, claims 1-76 fail to particularly point out and distinctly claim the invention under 35 U.S.C. § 112, second paragraph. (Examiner's Answer pp. 5 and 10-11). Applicant has addressed the new matter assertion above and does not understand how, being new matter, even if it was, makes the claim indefinite under 35 U.S.C. § 112, second paragraph. In any event applicant has fully addressed these indefiniteness argument as noted more specifically below. However, if the only support the Examiner has now for some of these arguments is that Exhibit A is new matter, which it is not, then they should be considered withdrawn or improper or both.

The Examiner has asserted the failure of Exhibit A to be published with the Dickens patent as issued also negates applicant's arguments that the Specification, in

¹ The examiner has complained that applicant did not specifically note where the Examiner did this. However, this is referenced in footnote 9 of Applicant's Appeal brief.

combination with the original prosecution of the Dickens patent, and as supported by the declarations of Winner and Toreson provides support for the interpretation of the Specification as originally filed to support the claims as added in the Reissue application. This argument of applicant pertains in either the case where Exhibit A is considered to have been filed with the Specification of the Dickens patent as originally filed or not. (Examiner's Answer pp. 4-5). This also makes no sense. What Exhibit A's status as new matter has to do with the other arguments to which applicant made reference in applicant's Appeal Brief is not understood.

By asserting only that Exhibit A was not printed in the Dickens patent as issued, the Examiner concedes, by in no way challenging, the correctness of applicant's assertions that the Specification of the Dickens patent, with or without Exhibit A, supports the claims as originally filed and as added in the Reissue application and also that support for this assertion lies in the Declarations of Winner and Toreson.

The Examiner has also taken the position that Exhibit A being new matter means that claims 32 and 69 are indefinite. Again, applicant does not understand the argument. Further applicant has specifically addressed this indefiniteness argument at pp. 57-58 of the December 2002 Response, repeated here by reference. The teaching of sorting by year, month and date would clearly indicate to one skilled in the art that a sort could be done by year only.

The Examiner has also asserted that the original Specification is devoid of support for the language in claims 33, 60-61, 64, 65 and 70 regarding "reformatting" "without changing." (Examiner's Answer at pp. 5-6)² Applicant has specifically addressed this assertion of the Examiner in the Response of December 2002, at pp. 58-59 and shown that based on the original Specification, as properly interpreted, including by reference to the prosecution history, indicates it was, and as supported by the Declarations of Winner and Thoreson, this claim language is supported. The Specification shows that this was in the possession of the inventor when the Specification was originally filed and enables one

² This forms part of a paragraph that, as noted above, appears based on indefiniteness arising because Exhibit A constitutes new matter, which it does not.

skilled in the art without undue experimentation. Applicant submits that Exhibit A adds even further support for this claim language.

The Examiner has taken the position that claims 16-30, 32, 34-67, 69-71, 75 and 76 are not supported in the Specification as originally filed. Applicant has already specifically addressed this argument of the Examiner in the Response of December 2002, at pp. 59-60.³

The Examiner has taken the position that claims 20, 21, 62-65 and 71 regarding "reformatting" or "storing" "separately," or claims 16-25, 31-33, 66-67 and 72 regarding "collectively further processing," or claims 36-37, 40-41, 48-49, 51-59 and 69 regarding running a program after the sorting operation, or claims 46-59 regarding "repeating the step of converting," are also not supported by the Specification as originally filed.⁴ (Examiner's Answer at p. 6) Applicant has already dealt in detail with these assertion of the Examiner at pp. 60-62 of the Response of December 2002 and repeats this by reference here. Applicant submits that Exhibit A adds further support for this claim language.

The Examiner has taken the position that language in claims 34-65 and 70-71 regarding converting by "windowing the symbolic representation" is not supported in the specification as originally filed. (Examiner's answer at pp. 6-7) Applicant has already specifically addressed this rejection of the Examiner in the Response of December 2, 2002, at p. 63, repeated here by reference.⁵

The Examiner has taken the position that claims like 35, 37, 39, 41, 43, 45, 49, 51, 53, 55, 57 and 59 relating to "opening the database prior to the step of converting" are not supported by the specification as originally filed. Applicant has already specifically addressed this assertion by the Examiner in the Response of December 2002, at pp. 63-64, including asserting that Exhibit A shows a program in which a database is opened prior to converting.⁶

³ See fn. 2.

⁴ See fn. 2.

⁵ See fn. 2.

⁶ See fn. 2.

The Examiner has taken the position that:

the claims call for the selection of a 'Y_aY_b value for the first decade' of a window. There is no known meaning for the 'value of a decade' and the original specification is devoid of any description of what the 'value of a decade' is. Because this subject matter was in the original disclosure, such limitation is not new matter. However, it is rejected under the second paragraph of 35 USC 112 because the meaning of the claim phraseology is so devoid as to be wholly indefinite. (Examiner's Answer at p. 7)

As noted by applicant before in the Response of December 2002, at p. 65, the Examiner has entirely misinterpreted the claim language. The claim recites "selecting a 10 decade window with a Y_aY_b value for the first decade." It is entirely plain from the language of the claim itself, but also with the explanation of the claimed invention in the Specification of the Dickens patent, that the "value" is not of "a decade" but of the numbers Y_aY_b selected for the first decade. That is, e.g., (19)85 for the first decade, i.e., (19)85 to 19(95), the first decade being 85-95 and the Y_aY_b value being 85.

The Examiner has criticized applicant for not pointing to specific paragraphs of the Winner or Toreson Declarations supporting the definiteness of the claims at issue. (Examiner's Answer at pp. 7-8) Applicant submits that the paragraphs themselves make clear the positions regarding applicant's arguments as to which they are submitted in support. The statements of Toreson and winner track specifically the arguments of applicant. The Examiner also criticizes the Declarations as "substantially reiterat[ing] the same arguments previously offered." Of course they would, the Declarations were submitted to support those arguments.

The Examiner has taken the position that applicant's arguments as to the inapplicability of the Shaughnessy reference do not comply with 37 C.F.R. 1.111 (b).

The Examiner states the:

since the statement of 'the interpretation of Shaughnessy [sic] reference, which applicant submits is adequately addressed in the 'prior arguments of applicant referenced above' amount to a general allegations that the claims define a patentable invention without specifically pointing out how the language of the

claims patentably distinguishes them from the Shaughnessy reference.

(Examiner's Answer, p. 8)

Applicant respectfully submits that Applicant's Responses of February 2002 and December 2002, which applicant has incorporated by reference into the Responses to later Office Actions and in Applicant's Appeal Brief, cannot possibly be deemed to fail to "present arguments pointing out the specific distinctions believed to render the claims ... patentable over any applied references" submitted in a *bona fide* attempt to advance the application or the reexamination to final action," and which "specifically point[] out how the language of the claims patentably distinguishes them from the references," as required by 37 C.F.R. §1.111 (b). They are full of analysis and interpretation of the pertinent references, including Shaughnessy, and specific claim language which the references fail to teach or suggest and indeed teach away from.

With regard to the Examiner's statements noted above and on pp. 8-10 concerning compliance with 37 C.F.R. 1.111 (b), applicant respectfully submits that all of applicants responses to Office Actions in the above captioned proceedings have been in compliance with 37 C.F.R. 1.111 (b). applicant does not understand the applicability of these comments of the Examiner to any rejection or objection to any claim on appeal here. The Examiner has also agreed with the issues noted by applicant in the Applicant's Appeal Brief, which do not indicate that any issue under appeal is the adequacy of response by applicant under 37 C.F.R. §1.111 (b).

As to the comments of the Examiner on pp. 11-12, applicant respectfully asserts that the opening of a reexamination proceeding 90/006,541 based on Japanese Published Patent Application No. 06-103133 ("Saka") presenting a "substantial new question of patentability," as required by the reexamination statute, 35 U.S.C. §303, was in error. The Examiner's have admitted this in the first office action after the opening of reexamination proceeding 90/006,541, and since then, by nowhere citing Saka as the basis for a rejection of any claim, and by stating, in at least one Office Action, and also in the present Examiner's Answer, that Saka does not present any substantially new question of patentability over and above those on record in the above captioned Merged Proceedings.

For this reason Reexamination 90/006,541 should be dismissed.

Regarding the Examiner's comments on p. 12-17 of the Examiner's Answer, including, e.g., p. 12, first full paragraph, applicant submits that regarding the recitation of claim 1 there referenced applicant has never asserted that Hazama did not show selecting YaYb earlier than the earliest date in the database (See, Response of December 2002, at p. 38). Rather the argument has been that the combination of references does not result in a *prima facie* case of obviousness because claimed elements are missing from the combination of references and/or no suggestion or motivation exists to combine the references, and/or the references would have to be modified significantly from the disclosed embodiment to even be able to be combined, etc.

Applicant believes that the discussion of Shaughnessy and its combination with Hazama and/or Booth contained in the Applicants Responses of February 2002 and December 2002 as referenced in Applicant's Appeal Brief, e.g., including, at pp. 10-19 of the Response of February 2002 and pp. 31-42 of the Response of December 2002, fully address the Examiner's assertions in the Answer.

In addition applicant respectfully submits that, as noted in the analysis of the referenced Responses, contrary to the Examiner's assertions below noted, Shaughnessy does not:

1. "convert[] a current date from a six-digit to an eight digit format before the converted date is returned for use in a particular application" (Examiner's Answer at p. 13, lines 3-4), rather Shaughnessy returns a parameter to the program (application) using Shaughnessy's disclosed called subroutine, indicating the result of some comparison of, e.g., a converted date to another converted date or a converted date to some date fixed by the application using Shaughnessy's date conversion subroutine program. As noted, this process is not the claimed process;

2. "suggest[] that the above approach can be useful to determine a century designator for converting each six digit date in a database to corresponding digit' [sic] dates" (Examiner's Answer at p. 13), rather Shaughnessy suggests performing Shaughnessy's subroutine program on at most a couple of dates at a time. This, again, is not the claimed process;

3. "refrain from such an approach ... on economic ... grounds," (Examiner's Answer at p. 13, lines 9-10) rather Shaughnessy, if suggesting to refrain from anything, suggests not going into the legacy database itself and changing the date data fields within the legacy database, which applicant also teaches, the difference between Shaughnessy and the Dickens patent being the approaches selected to avoid having to take this unacceptable approach.

As to the Examiner's comment in the Examiner's Answer at p. 13, lines 11-19, Shaughnessy does not teach or suggest "extrapolating" Shaughnessy's disclosed method "to an entire database," and even if Shaughnessy did, that extrapolation would not be the claimed invention. The referenced sections of Shaughnessy do not teach or suggest the claimed invention, but rather refer to calling up Shaughnessy's subroutine which at most compares one or two dates, one or both of which may be windowed to remove the century ambiguity, along with another set of operations resulting not in any reformatting of all of the dates in a database for further processing, but in the returning of a parameter to an application calling the Shaughnessy subroutine indicating the result of the single comparison.

Applicant does not claim windowing but rather a specific application of windowing very different from the utilization made by Shaughnessy.

Regarding the Examiner's comment that "[s]uch reformatted dates are further utilized by returning one date field with the converted date to the subroutine and by returning a parameter to the application program for use in further operations." (Examiner's Answer at p. 14, lines 14-16) The reasons that Shaughnessy and Hazama do not teach or suggest the relevant claim language has been addressed at pp. 12-13 of the Response of February 2002 and p. 37 of the Response of December 12, 2002. In addition, however, the Examiner has neither stated the teaching of Shaughnessy correctly nor applied it to the actual claim language. The "reformatted dates" in Shaughnessy are "further utilized" in Shaughnessy's subroutine and not returned for utilization in the application program, e.g., for sorting by that program.

Regarding the Examiner's comments starting on the bottom of p. 14 of the Examiner's Answer, the reasons that the references do not disclose or suggest the

pertinent claim recitations are discussed fully at p. 13-14 of the applicant's Response of February 2002. In addition, like all of the Examiner's further comments of a substantive prior art nature from p. 14 to 17, relating to the application of Shaughnessy to the claims as the main reference, relate to claims that depend from claim 1, and should be allowable with claim 1.

Regarding the Examiner's comments on pp. 17-19 regarding the utilization by the Examiner of Booth rather than Hazama or vice-versa, applicant submits that applicant's positions that the combination of references did not result in a *prima facie* case of obviousness, because the combination(s) lacked claimed elements of the Dickens method, and/or there was no suggestion or motivation to combine the references, and/or the references would have to be significantly modified from their actual teachings to be combined, etc. are still valid arguments.

With regard to the Examiner's comments on pp. 17-19 of the Examiner's Answer, with respect to Booth, applicant submits that the reasons that Booth is not applicable to the claimed inventions in the above captioned merged proceedings has been adequately addressed at pp. 16-21 of the applicant's Response of February 2002 and pp. 41-42 of the Response of December 2002. In addition, the disclosure of Booth on the referenced pages 845 and 942 does not disclose what is claimed in the Dickens patent as issued.

The disclosed functions have nothing to do with converting dates in a database to eliminate century ambiguity due to being stored with only a two character year designation. As noted in the discussions of Booth just referenced, Booth does not have to worry about this problem since it stores dates in its database in integer format, meaning the century of the stored date is always fully characterized and not characterized in a truncated two character format, that leads to the Y2K century ambiguity problem solved by the Dickens patent. The disclosed functions of Booth convert stored date data into string format for certain reasons, and the string format has two characters for the century date. But the date data is not converted according to the claimed invention, because it is not stored in the claimed format wherein the century characters are absent in what is stored.

With respect to the Examiner's comments on pp. 21-25 of the Examiner's Answer applicant submits that the reasons that Ohms is inapplicable to the claimed invention, have been fully addressed, e.g., at pp. 22-25 of applicant's Response of February 2002 and pp. 51-53 of the Response of December 2002. Much like Booth, Ohms teaches storing data in Lilian format wherein the century ambiguity problem does not exist. For purposes of application of Booth or Ohms to the Dickens patent claims, Lilian and integer formats are identical in storing in a database date information that fully describe the year date data, century and decade and thus have nothing to do with the claimed invention converting dates that are in fact century ambiguous.

In addition, applicant notes that the notation in table 1 of Ohms that dates can be converted from, e.g., a short Julian format with two year characters to one with four characters, including the two century characters and the suggestion of doing so using windowing (p. 248) *for purposes of entering dates into the database*, does not change the fact that Ohms does not and cannot teach or suggest the claimed invention because the dates stored in and manipulated in the Ohms database are in Lilian format. and, therefore, not century ambiguous and without any Y2K ambiguity problem.

Furthermore, the Examiner's Answer has not complied with the requirements for an Examiner's Answer in specifically stating any rejections that have been withdrawn as a result of applicant filing Applicant's Appeal Brief. However, neither has the Examiner's Answer complied with the requirement to specifically state every claim rejected and specifically apply the cited references against each claim limitation.

The Examiner's Answer, however, fails to address *at all* any of the rejections of claims 11-15 from the originally issued Dickens patent claims, or any of the claims 16-75 added by the Reissue application filed by applicant in the above captioned merged proceedings, based on 35 U.S.C. §103 (a), i.e., based on prior art. All of the Examiner's comments in the "Response to Argument" section of the Examiner's Answer relate to arguments concerning rejections of claims 1-10 as originally issued in the Dickens patent.

Applicant concurs with what the Examiner has apparently conceded, that the art does not contain teaching or suggestion of any of the inventions recited in claims 10-15 or claims 16-76 and respectfully requests that the Examiner be directed to allow these

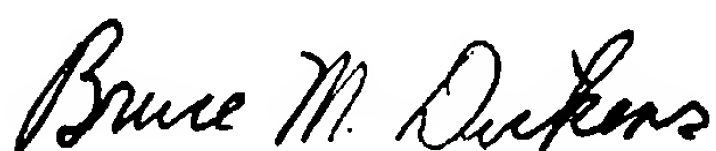
claims. The M.P.E.P. §1207.02 indicates that rejections not included in the Examiner's Answer, even if not specifically referenced by the Examiner as no longer being asserted, should be considered as withdrawn.

The Examiner has specifically withdrawn the objection to the Reissue Oath and Declaration, which is the only other rejection in the Office Action from which this appeal is taken.

Conclusion

For the above stated reasons, applicant submits that claims 1-78 at issue in the above captioned merged proceedings should be allowed and the Reexamination proceedings dismissed.

Respectfully submitted,



Bruce M. Dickens

949-857-1487

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Bruce M. Dickens

(Name)

(Signature)

May 30, 2006

MAIL STOP: AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Commissioner:

Enclosed is a Applicant's Reply Brief in the merged cases:

Reissue Application No.:) Group Art Unit: 2161

09/512,592)

United States Patent No.:) Examiner: Coby, F.

5,806,063)

Issued: September 8, 1998) Confirmation No.: 3314

Applicant:)

Dickens-Soeder2000,LLC)

Reexamination Proceeding:)

90/005,592)

Filed: December 21, 1999)

Reexamination Proceeding:)

90/005,628)

Filed: February 2, 2000)

Reexamination Proceeding:)

90/005,727)

Filed: May 16, 2000)

Reexamination Proceeding)

90/006,541)

Filed February 2, 2003)

This mailing consists of:

Applicant's Reply Brief

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If you have any questions, please do not hesitate to contact me.

Regards,

Bruce M. Dickens

Bruce M. Dickens

949-857-1487

Date of Facsimile transmission: **May 30, 2006**

I hereby certify that this paper is being sent via facsimile (571.273.8300) transmitted to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 (571 273 8300) on the date indicated above.

Bruce M. Dickens

(Name)

Bruce M. Dickens

(Signature)

CERTIFICATE OF SERVICE BY MAIL

May 30, 2006

Re: Notice of Appeal in the merged cases:

Reissue Application No.:) **Group Art Unit: 2161**

09/512,592)

United States Patent No.:) **Examiner: Coby, F.**

5,806,063)

Issued: September 8, 1998) **Confirmation No.: 3314**

Applicant:)

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Reexamination Proceeding:)

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Reexamination Proceeding:)

90/005,727)

Filed: May 16, 2000)

Reexamination Proceeding)

90/006,541)

Filed February 7, 2003)

I hereby certify that I have served the following on the below listed counsel of record by placing same in a first class mail envelope addressed to the below listed addresses with appropriate postage affixed and deposited with the United States Post Office:

Applicant's Reply Brief

Cover Letter

Paul E. Crawford
Connolly Bove Loge and Hutz LLP
1200 Market Street
Wilmington, DE 19801

Ross F. Hunt Jr.
Larson & Taylor
1199 North Fairfax St., Suite 900
Alexandria, VA 22314

Stanley B. Green
Connolly Bove Loge and Hutz LLP
1990 M Street, NW

Washington, D.C. 20036

Bruce M. Dickens

Bruce M. Dickens
949-857-1487